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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,570	12/21/2001	Herbert Jaineck	178/50786	2454

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EXAMINER

CECIL, TERRY K

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/024,570

Applicant(s)

JAINEK, HERBERT

Examiner

Mr. Terry K. Cecil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7-8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

*The specification and drawings filed 3-29-2002 appear to be duplicates of that originally filed, since amended copies thereof showing the changes made was not included. Confirmation is requested.*

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-4 and 8 are rejected under 35 U.S.C. 102(a) as being anticipated by the Japanese Reference (11-033313), hereinafter "313. As shown in figure 4, '313 discloses a filter arrangement having a filter element which is axially inserted into a filter housing 22 to seal a backflow return channel 26. The arrangement includes a first seal 39 in front of<sup>d</sup> the return channel and a second seal 37, wherein upon withdraw of the filter element the first seal (the square portion of 39) unseats to allow the unfiltered oil to drain through channel 26 (see paragraph [0031] of the included translation) and thereafter seal 37 unseats to allow oil on the filtered side to drain [as in claim 1], because the range of motion of the second seal is greater [as in claim 2]. Notice that the square portion of seal 39 seats against an axial projection of the housing therebelow [as in claim 3] that lies between the inlet and the drain return channel [as in claim 4]. The filter is configured for filtering oil [as in claim 8].

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3. Claims 1-5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by The European Reference (EP-1,031,367-A1), hereinafter "367". As shown in figure 4, the axially installed filter seals a return drain channel 10 upon installation. Member 15 is provided on the disc 4 to create a first seal in front of the channel 10 and a second seal against the filtered flow outlet pipe 9. The arrangement is configured such that upon axial withdraw of the filter the first seal is unseated followed by the second seal [as in claim 1] because the second seal has a longer range of motion [as in claim 2]. Notice that the first seal seats against an axial projection of the housing that defines the return channel [as in claim 3] part of which lies between the inlet 6 and the drain return channel [as in claim 4]. The seal 15 also extends radial to form the second seal [as in claim 5]. The filter is configured for filtering engine fluids [as in claim 8].

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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<sup>1</sup> The phrase "in front of" is interpreted as "upstream of"

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5. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over '367 in view of '313. '367 has been expanded above. Claims 6 and 7 have limitations concerning the first seal extending radially outward beyond a radial edge of the filter to form a membrane surface in front of the liquid inlet to partially block backflow, wherein the membrane surface cooperates with a stop surface on the housing. As shown in figure 4, '313 teaches a seal member having a radial extension cooperating with the housing to prevent backflow of unfiltered liquid [as in claims 6-7]. Upon modification of '367 with the radial extension of '313 the seal 15 would extend radially beyond the filter to contact the housing (the contact point of which acts as a stop). It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the radial extension of '313 on the seal 15 of '367, since '313 teaches the benefit of preventing return flow of unfiltered liquid when the engine is shut off.

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6. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (703)305-0079 for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:00a to 4:30p, on at least four days during the week M-F.
- The group receptionist can be reached at (703)308-0661 for inquiries of a general nature or those relating to the status of this or proceeding applications.
- Wanda Walker, the examiner's supervisor, can be reached at (703)308-0457 if attempts to reach the examiner are unsuccessful.
- Fax numbers for this art unit are as follows:
  - i. (703)872-9310 for *official* faxes (i.e. faxes to be entered as part of the file history) that are not after-final; and
  - ii. (703)872-9311 if after-final.

Examiner Terry Cecil  
A.U. 1723

TKC  
May 15, 2003